

## **REMARKS**

Claims 31-53 are pending in the application. Claims 31-53 stand rejected. Applicants' representative herein amends claims 31, 38, 45, 52 in addition to amendments made during the Final Response. Claims 54- 56 are new claims. No new matter has been added. Further review is respectfully requested in view of the amendments and following remarks.

### **I. Examiner Interview**

Applicant's representative respectfully request the Examine to grant a telephonic interview to discuss the current amendment and cited prior art references prior to issuance of further Office Action.

### **II. Rejection of Claims 31, 38, and 45 Under 35 U.S.C. § 101**

Claims 31, 38, and 45 stand rejected under 35 U.S.C. §101 because the Examiner asserts that the claims "do not produce a useful, concrete and tangible result." (Office Action pg 2). Applicants' representative respectfully submit that the "useful, concrete and tangible result" test is no longer sufficient for determining whether a claim satisfies §101. Rather, the proper test is be the machine-or-transformation test. *In re Bilski*, 545 F.3d 943, 20 (Fed. Cir. 2008)(en banc).

" [T]he proper inquiry under §101 is not whether the process claim recites sufficient "physical steps," but rather whether the claim meets the machine-or-transformation test... a claim that purportedly lacks any "physical steps" but is still tied to a machine or achieves an eligible transformation passes muster under §101." (*In re Bilski* at 23.) "The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies §101 either by showing that his claim is tied to a particular machine, or by showing that his claim transform an article." (*Id.* at 10, citing *Gottschalk v. Benson*, 409 U.S. 63, 70, 93 S. Ct. 253, 34 L. Ed. 2d 273 (1972)).(emphasis added).

Specifically regarding claim 31, as is clear from the claim language, all the steps are tied to a machine. (e.g., “a server located at a computerized system”). Since the steps involve the transfer of electronic receipts, at least one computer device is required by claim 31 in order to efficiently and effectively obtain the correct receipt and send it to a remote device and thus is not a insignificant part of the claim. (*See Parker v. Flook*, 437 U.S. 584, 590, 98 S. Ct. 2522, 57 L. Ed. 2d 451 (1978)). Accordingly, withdrawal of this rejection is respectfully requested.

Regarding claims 38 and 45, the claims have been further clarified to include a computerized system and a processor coupled with computer memory respectively. Thus, Applicants’ representative respectfully submit that the Examiner has erroneously ignored structural aspect of claims 38 and 45. *In Re Lewis Ferguson* (Serial Number 09/981,823) (Fed. Cir. 2009) explains in part:

“In State Street, as is often forgotten, we addressed a claim drawn not to a process but to a machine.” *Bilski*, 545 F.3d at 959 n.18; see also State Street, 149 F.3d at 1373 (“Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a [patent-eligible invention] because it produces a useful, concrete and tangible result . . .” (internal quotation marks omitted) (emphasis added)). The claim at issue in State Street was thus drawn to a patent-eligible machine implementation of what may have otherwise been a non-patent-eligible abstract idea. (emphasis in original, pg 8 of the opinion In Re Lewis Ferguson).

Accordingly, since claims 38 and 45 are clearly tied to a machine, they are patentable subject matter even if it may have otherwise been an abstract idea.

Nevertheless, claims 31, 38 and 45 do produce useful, concrete and tangible results. By generating electronic receipts from stored data and thereafter transmitting it to a remove device, it produces the useful and tangible results of an electronic receipt that can help a customer memorialize their purchase. The electronic receipt also simplified future return or exchange transactions. Accordingly, withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 31-53 Under 35 U.S.C. § 103**

Claims 31-53 stand rejected under 35 U.S.C. §103(a) over Mäkipää *et. al.* US 6,394,341 (“Mäkipää”) in view of Hoffman *et. al.* US 2002/0109007 (“Hoffman”). Withdrawal of this rejection is respectfully requested for at least the following reasons. Mäkipää and Hoffman are not properly combinable to establish a *prima facie* case of obviousness because both cited references fails to disclose, teach, or suggest all claimed features.

Hoffman relates to apparatus and methods for providing a consumer means to access a digital receipt generated as a result of a single purchase transaction. In one example, Hoffman discloses a retail terminal that is operable to: “(i) produce a digital receipt corresponding to a purchase transaction; (ii) obtain a network address corresponding to a storage location of the digital receipt in the addressable storage medium; (iii) store the digital receipt at the network address in the addressable storage medium; (iv) provide the network address to the printer; and (v) cause the printer to print the network address in the machine-readable form.” ([0011]). However, Hoffman is silent with regards to “*each receipt associated with a receipt card having a magnetic strip encoded with information that identifies an electronic address of the database and information that identifies a receipt card account number.*”

In clear contrast, Hoffman merely discloses a system that generates and saves digital receipts for individual stores. Thereafter, a customers can access the digital version of their receipt online. However, while a customer may be given a card with encoded information about each transaction, this card is not linked to any account. If a customer made several transactions, the customer will be given several encoded cards; one for each individual transaction.

According to Hoffman, “the paper receipt is given to and retained by the consumer while the digital receipt is forwarded to a storage location... ***the digital receipt is assigned a storage address*** that is accessible via the network by a network enabled apparatus... Additionally, ***the address for the stored digital receipt is encoded or printed onto the paper receipt***... The address may also be encoded onto a magnetic strip such as is readable by a card reader.” ([0034]). Thus, it appears that after each new transaction, a consumer under Hoffman’s system will receive a new encoded card containing a new address for the digital receipt because each new transaction will generate a new address. Most importantly, this also

indicates that Hoffman fails to teach a receipt card that identifies a receipt card account number. As depicted in Figure 1, each store (12) in the Hoffman system will have its own system for assigning digital receipts. Thus, there will be no receipt card account number since each transaction is a separate event. Thus, Hoffman cannot be said to teach or suggest: “*each receipt associated with a receipt card having a magnetic strip encoded with information that identifies an electronic address of the database and information that identifies a receipt card account number*” as recite in claims 31, 38, 45, and 52.

Regarding newly added claim 55, both Mäkipää and Hoffman fail to teach the element:

associating a receipt card with a user and a receipt card identification number, wherein the receipt card identification number is associated with a receipt card account, wherein the receipt card have a magnetic strip encoded with information indicative of the receipt card identification number, wherein the receipt card account is associated with a plurality of electronic receipts;

Mäkipää discloses a system of consolidating electronic receipts to be utilized for business and personal accounting and financial management. While the cited reference allows a user to view transaction onlines in great detail, Mäkipää does not teach a receipt card. In Mäkipää’s system, electronic receipts are send directly to a client device from a point of sale (transaction provider). Column 8, line 54-61 provides in part:

The transaction provider 12 provides at least an electronic receipt of financial transactions offered, by the transaction provider to the user of the user device 14 but typically also provides electronic data transmissions identifying financial transactions which are offered by the transaction provider which is a mechanism to induce purchase by the user of the user device 14 of financial transactions offered by the transaction provider 12.

Thus, no receipt card is necessary in the Mäkipää system since receipts are directly send to the user’s device. Furthermore, it is also not necessary to have a receipt card in association with a receipt card identification number.

Similarly, Hoffman does not teach a receipt card. As explained above, the Hoffman

system does not require a receipt card in association with a receipt card identification number because each transaction stands alone and requires a different identification number. Thus, a receipt card account cannot be associated with multiple receipts. Therefore Mäkipää and Hoffman cannot be said to teach the aforementioned feature of claim 55.

In view of at least the foregoing, Mäkipää and Hoffman are not properly combinable for the purpose of establishing a *prima facie* case of obviousness. Both Mäkipää and Hoffman fail to disclose or suggest at least the above-identified features. Accordingly, reconsideration and withdrawal of the outstanding rejection to claims 31, 38, 45 and 52 is respectfully requested. Each of claims 32-37, 39-44, and 46-52 depend directly or in directly from independent claims 31, 38, 45 and 52, respectively, and are believed allowable for the same reasons. Claims 54-56 are patentably distinct for the reason explained above.

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**PATENT**

## **CONCLUSION**

Applicants' representative request the Examiner reconsider the rejections and issue a Notice of Allowance of all the claims.

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